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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/365,586 | 07/30/1999 | ARTHUR MICHAEL KELLER | | 1954 |

23349 7590 12/18/2002
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MYHRE, JAMES W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3622 | |

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | |
|--------------------------------------|-------------------------------------|
| Application No. 09/365,586 | Applicant(s) Keller et al |
| Examiner James W. Myhre | Art Unit 3622 |



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 18, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-35 and 37-72 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 1-23 and 59-72 is/are allowed.

6) Claim(s) 24-35 and 37-58 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on November 18, 2002 has been considered but is ineffective to overcome the Bisbee et al (5,615,268), Talati et al (5,903,878), and Jermyn (6,026,370) references.

Allowable Subject Matter

2. Claims 1-23 and 59-72 contain allowable subject matter.

Statement of Reasons for the Indication of Allowable Subject Matter

3. The following is a statement of reasons for the indication of allowable subject matter: While prior art was found which disclosed registering a plurality of electronic commerce customers, receiving transaction acknowledgments pertaining to electronic commerce transactions, and storing the acknowledgment information into a database, prior art could not be found which disclosed setting up a separate registered electronic mail (email) account for a registered electronic commerce customer, accepting transaction acknowledgment emails from electronic commerce retailers (Claim 1), storing the acknowledgment information into a transaction database (Claim 2), and forwarding the acknowledgment email to the electronic commerce customer's customer email address (Claim 3) or to a web site (Claim 4). Therefore,

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the Examiner considers use of a separate email account to which merchants submit transaction acknowledgment emails pertaining to the customer's electronic commerce transactions as the novelty of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 24, 39, 40, 43, 52, and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Bisbee et al (5,615,268).

Claim 24: Bisbee discloses a method for tracking electronic commerce information, comprising:

- a. Accepting a registration from an electronic commerce customer (col 3, lines 58-67);
- b. Assigning an electronic identification code to the customer (i.e. customer's public/private key and PIN)(col 3, lines 60-64);
- b. Automatically forwarding information from an electronic acknowledgment of an electronic transaction executed by the customer (i.e. the transaction data along with the digital signature and time stamp)(col 5, lines 1-28 and 43-54); and

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c. Storing the information from the electronic commerce transaction acknowledgment into a transaction file associated with the customer code within an electronic transaction database (col 5, lines 30-42).

Claims 39 and 40: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, and further discloses accessing an electronic commerce site using authentication information, such as a username and password (col 5, lines 28-35).

Claim 43: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, and further discloses retrieving (datamining) the information from the transaction database (col 5, lines 30-42).

Claim 52: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, and further discloses assisting the customer with their interaction with the electronic retailer. The Examiner considers the whole of the Bisbee invention to be “assisting the customer” in that it verifies the transaction information, the authenticity of the customer, the retailer, and payment information. All of which assist the customer in the transaction.

Claim 53: Bisbee discloses a method for tracking electronic commerce information as in Claim 52 above, and further discloses verifying the authenticity of the transaction information so it “can be used at a future date to prove conclusively that a party initiated or received a transaction” (col 5, lines 22-23), such as when a customer is returning the product for replacement or refund as is normal practice within the retail arts.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25-35, 37, 38, 41, 42, 46-51, and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisbee et al (5,615,268) in view of Talati et al (5,903,878).

Claim 25: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, but does not explicitly disclose automatically parsing the electronic commerce transaction acknowledgments to obtain the information. However, Talati discloses a similar method for tracking electronic commerce information in which the acknowledgments are transmitted via email messages, which are then parsed to retrieve the information (col 10, lines 53-60 and col 11, lines 2-8). The Examiner notes that parsing locates and extracts data from within a document. Therefore Talati's extraction of the relevant data from the email is the equivalent of the Applicant's parsing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to parse the electronic commerce acknowledgments being received in the Bisbee information to extract the relevant data. One would have been motivated to extract the data in this way in order to eliminate extraneous data

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from the file, such as the routing trace information attached to files as they are sent through the nodes of the Internet.

Claims 26 and 42: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, but does not explicitly disclose that the electronic transaction acknowledgment is a web pages. However, Talati discloses a similar method for tracking electronic commerce information and also discloses that the transaction data could be translated into HTML for display upon a web browser (e.g. displayed as a web page)(col 12, lines 42-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the transaction data in Bisbee onto a web page for retrieval by interested parties, such as the customer. One would have been motivated to place the data on a web page in order to prevent merchants from needing to store the email addresses for every customer and their corresponding central processor.

Claim 27: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 26 above. As discussed in reference to Claim 25 above, Talati also discloses parsing the electronic commerce transaction acknowledgment to retrieve the information. Therefore, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to parse the transaction data on the web page to retrieve the information. One would have been motivated to extract the information in this way from the web page in order to eliminate extraneous data from the file, such as the HTML formatting codes.

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Claims 28 and 41: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, but does not explicitly disclose that the document (acknowledgment) is delivered in the form of an email. However, Talati discloses a similar method for tracking electronic commerce information in which email is used to transfer the document between the participants (col 8, lines 17-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit the documents on Bisbee via email messages using their corresponding email addresses. One would have been motivated to use an email system in order to provide “a traceable delivery system” as discussed by Talati.

Claim 29: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 28 above. As discussed in reference to Claims 25 and 27 above, Talati also discloses parsing the electronic commerce transaction acknowledgments to retrieve the information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to parse the transaction data in Bisbee to retrieve the information. One would have been motivated to extract the information in this way in order to eliminate extraneous data from the file, such as the routing trace information attached to files as they are sent through the nodes of the Internet.

Claim 30: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 28 above. Both references also disclose that the transaction information can be received directly from the merchant (Bisbee, col 8, lines 32-36)(Talati, col 10, lines 53-60).

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Claims 31 and 35: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 28 above. Both reference also discloses that the transaction information can be received directly from the customer (or via the customer's email server)(Bisbee, col 5, lines 36-42)(Talati, col 11, lines 11-16).

Claims 32 and 33: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 31 above. Talati further discloses automatically identifying and sending the email messages by the email-serving sites (delivery system)(col 1, lines 27-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically generate the transaction acknowledgments in Bisbee. One would have been motivated to automate this process in order to eliminate that need for "human" intervention, thus speeding up the entire transaction process.

Claim 34: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 31 above. While neither reference explicitly disclose that the email-server is also an Internet Service Provider, Official Notice is taken that it is old and well known for Internet Service Providers to offer email service to their subscribers. The Examiner notes that in the past ten years each and every Internet Service Provider personally utilized by the Examiner, such as Erol's and America On-Line (AOL), provided email services. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the email-serving sites in the references could also provide Internet connection services (i.e. be Internet Service Providers). One would have been motivated to use the participant's Internet

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Service Provider as the email serving site in order to eliminate the need for the participant to register and pay another email server.

Claims 37 and 38: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 24 above. Talati also discloses the customer's computer automatically identifying and sending an electronic transaction acknowledgment email (col 11, lines 2-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically identify and send the transaction acknowledgment email by the customer computer in order to eliminate the need for "human" intervention, thus speeding up the entire transaction process.

Claim 46: Bisbee discloses a method for tracking electronic commerce information as in Claim 43 above, but does not explicitly disclose that the electronic transaction information comprises customer demographic information. However, Talati discloses a similar method for tracking electronic commerce information which also maintains customer demographic information, such as account number, originator's personal information (col 9, lines 39-41), birth date, mother's maiden name, social security number (col 11, lines 1-2), delivery address, etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such personal information into the transaction database. One would have been motivated to include this type of information in order to facilitate the identification of the customer during the transaction and during the retrieval of the information (ensuring only "authorized" requests are filled).

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Claims 47-50: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, but does not explicitly disclose that the electronic transaction information includes the name and cost of the products purchased. However, Talati discloses a similar method for tracking electronic commerce information which also maintains the products purchased, their cost, transaction identifiers, shipping information and other information in the transaction database (col 3, lines 12-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store all of the information pertaining to the transaction in Bisbee's transaction database, to include the products purchased and their costs. One would have been motivated to include these types of data in the transaction database in order to facilitate the retrieval and verification of the transaction data at a later time as disclosed by Bisbee (col 5, lines 43-54).

Claim 51: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 50 above. While neither reference discloses accessing a third party shipping Internet site to retrieve shipment status information, the Examiner notes that it is old and well known within the shipping industry to make such information available to their customers. Most, if not all, major shipping companies, such as FedEx, UPS, and DHL, offer shipment tracking features online (See Shavit et al listed below). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer to access a third party shipping site to retrieve shipping status information. One would have been

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motivated to allow access to such a site in order to customer to better plan for the arrival of the ordered products, e.g. just-in-time delivery.

Claims 55, 56, and 58: Bisbee discloses a method for tracking electronic commerce information as in Claim 24 above, but does not explicitly disclose updating the transaction database with shipping information. However, Talati discloses a similar method for tracking electronic commerce information, which also discloses including the shipping information in the transaction database by receiving the information from the customer (col 10, lines 64-66) or the retailer (col 12, lines 35-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include and update shipping information in the Bisbee transaction database. One would have been motivated to include and update this information in order to enable both the customer and the merchant to verify the delivery address for the products.

Claim 57: Bisbee and Talati disclose a method for tracking electronic commerce information as in Claim 55 above. Talati also discloses that the transaction information (to include the delivery address/shipping information) is formatted into HTML and made available on a web page as discussed in reference to Claims 26 and 42 above.

Claim Rejections - 35 USC § 103

8. Claims 44, 45, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisbee et al (5,615,268) in view of Jermyn (6,026,370).

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Claims 44, 45, and 54: Bisbee discloses a method for tracking electronic commerce information as in Claim 43 above, but does not explicitly disclose that the electronic transaction information retrieved from the transaction database comprising a list of products often purchased using electronic commerce transactions or the relative popularity of various electronic commerce sites. However, Jermyn discloses a similar method for tracking electronic commerce information which also discloses using the information in the transaction database, such as products purchased, popularity of electronic retailers, etc. to target special offers to a subset of customers (see Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the information stored in the database of Bisbee to present targeted offers to one or more of the customers. One would have been motivated to use the stored information in this way in order to provide another avenue of revenue for the system operator.

Response to Arguments

9. Applicant's arguments filed November 18, 2002 have been fully considered but they are not persuasive.

Applicant argues that none of the cited references disclose a system that performs "automatically forwarding information from an electronic commerce acknowledgment after said first electronic customer has executed an electronic commerce transaction" (pages 12-13). The Examiner notes that Bisbee discloses that the electronic commerce transaction information, along

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with the digital signature and time stamp, is automatically forwarded (transmitted) from the customer's (Transfer Agent) personal computer (col 5, lines 1-4) to the Authentication Center which verifies the identity of the customer and stores the document (transaction acknowledgment) "in a manner which cannot be repudiated" (col 5, lines 16-42).

The Examiner also notes that the Applicant has not argued against the Official Notice taken in the office action of June 11, 2002 (paper number 10) in the rejection of Claim 34 pertaining to Internet Service Providers also providing email service to their members. Therefore, the Examiner considers this as an admission by the Applicant that this feature is well known in the art.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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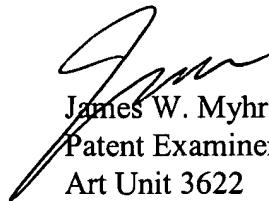
will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
December 13, 2002


James W. Myhre
Patent Examiner
Art Unit 3622